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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,682	12/31/2003	Brian Andrew Phillips	2043.035US2	2158
49845 7590 01/13/2009 SCHWEGMAN, LUNDBERG & WOESSNER/EBAY P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
FADOK, MARK A				
ART UNIT		PAPER NUMBER		
3625				
NOTIFICATION DATE		DELIVERY MODE		
01/13/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM

Office Action Summary

Application No.

10/749,682

Applicant(s)

PHILLIPS ET AL.

Examiner

MARK FADOK

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The examiner is in receipt of applicant's response to office action mailed 7/9/2008, which was received 10/7/2008. Acknowledgement is made to the amendment to claim 16, leaving claims 16-20 as open to prosecution. Applicant's amendment has been carefully considered and was found to be persuasive, however, after further search and consideration a new ground of rejection is provided below:

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. In this case the phrase "such that the interaction appears as being directly from the sender" is indefinite because the examiner is unable to ascertain to what degree the viewer is recognizing the appearance as being directly from the seller.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiloh (US PG PUB 2001/0037316) and further in view of Lussow et al (US PG PUB 2004/01553424).

In regards to claim 16, Shiloh discloses a system comprising:

a web server (FIG 1, item 15); and

an integrated shipping server hosted by a third party payment service, linked in communication with the web server (FIG 2, item 34),

the web server and integrated shipping server, acting as an intermediary server between a sender and a shipping vendor (FIG 2), comprising

software instructions that when executed enable the sender to arrange for shipment of a package to a recipient via the shipping vendor by performing operations, by the integrated shipping server (para 0090), including:

generating and serving web pages via which shipping information including sender address may be automatically entered into the web pages (para 0085 and 0087), and

interacting with an on-line interface hosted by the shipping vendor to arrange for shipment of the package via the shipping vendor through use of the shipping information (para 0085 and 0087 and 0090);

receiving shipping data pertaining to the shipment from the shipping vendor (para 0090),

Shiloh teaches sending shipping data to a shipper, but does not specifically mention that the shipping data is a shipping label served via a web page that can be printed, Lussow teaches shipping data is a shipping label served via a web page that can be printed (Lussow, para 0071). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Shiloh returning a shipping label that can be printed out, because this will increase efficiency by providing the label electronically rather than mailing or having the sender pick up the label, thus saving time and aggravation on the part of the sender.

in regards to shipping vendor registering the sender, The combination of Shiloh and Lassow teach knowledge of an optimal dispatch site for pick up of a sender's item by a shipper for delivery to a buyer (Shiloh, para 0032, 0054 and 0090), but does not specifically mention that the vendor is registered with the shipping vendor. Walker teaches registering seller addresses (FIG 4). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Shiloh and Lassow registering the vendor with the shipper and then using the information to ship the product, since this will allow for easy retrieval of the senders address without having to have the sender repeatably enter the same information, thus making the system more user friendly.

In regards to the phase "such that the interaction appears as being directly from the sender", this phase is given little patentable weight since the limitation offers no structure and is basically a result and not an actionable step. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

In regards to claim 17, the combination of Shiloh and Lussow, teach a payment server linked in communication with the integrated shipping server and comprising further software instructions that when executed perform the operation of facilitating payment for the shipment from the seller to the shipping vendor (Lussow, para 0007 and 0055).

In regards to claim 18, the combination of Shiloh and Lussow teach wherein the system is configured to be operable by a third-party payment service for which the seller has an account, and facilitating payment of the shipment comprises:

providing payment from the third-party service to the shipping vendor; and deducting a shipping cost of the shipment from the seller's third-party payment service account (Lussow para 0055)).

In regards to claim 19, the combination of Shiloh and Lussow teach wherein payment from the third-party service to the shipping vendor is facilitated via interaction between the payment server and a debit/credit card authorization/settlement network (Lussow para 0055 and Shiloh 0026,0028, 0033).

In regards to claim 20, the combination of Shiloh and Lussow teaches generating a virtual debit card; and employing the virtual debit card to pay the shipping vendor (Shiloh, para 0026 and FIG 2).

Further in regards to claims 17-20 and the combination of Shiloh and Lussow, it is noted that all of the elements of the cited references perform the same function when combined as they do in the prior art. Thus such a combination would have yielded predictable results (see Sakraida, 425 US at 282, 189 USPQ at 453. Since the claims

only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Response to Arguments

Applicant's arguments with respect to claims 10-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300

[Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/

Primary Examiner, Art Unit 3625